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Docket No. GJE-90
Serial No. 10/089,873Remarks

Claims 1-12 were previously pending in the subject application. By this Amendment, claims 9 and 11 have been amended and claims 1-8, 10 and 12 have been withdrawn. Support for the claim amendments can be found throughout the subject specification. No new matter has been added by these amendments. Accordingly, claims 9 and 11 are currently before the Examiner for consideration.

The amendments to the claims have been made in an effort to lend greater clarity to the claimed subject matter and to expedite prosecution by focusing the claims on allowable subject matter. These amendments should not be taken to indicate the applicant's agreement with, or acquiescence to, the rejections of record. Favorable consideration of the claims now presented, in view of the remarks and amendments set forth herein, is earnestly solicited.

As an initial matter, the applicants confirm the election of Group II (claims 9 and 11) as provisionally elected in a telephonic conversation of April 5, 2004. The applicants wish to thank the Examiner for assigning Claim 11 to group II.

Claims 9 and 12 have been rejected under 35 U.S.C. § 112, second paragraph, as indefinite. This is believed to be a typographical error; claims 9 and 11 were elected, and claims 9 and 11 appear to be the subject of the current office action. The claims have been amended herein to address the issue raised by the Examiner and to lend greater clarity to the claimed subject matter. The applicants respectfully traverse this ground for rejection to the extent that it might be applied to Claims 9 and 11 as now amended.

Claim 11 has been rejected under 35 U.S.C. § 102(b) as being anticipated by either Heyer *et al.* (U.S. Patent No. 5,363,604) or Heyer *et al.* (U.S. Patent No. 5,685,935). The applicants respectfully traverse this ground of rejection and aver that each and every element of the claimed invention is not taught by the cited references.

Of course, it is well established that to anticipate, a single prior art reference must disclose all of the elements of the claimed invention. In *Lindemann v. American Hoist and Derrick Co.*, 221 USPQ 481 (Fed. Cir. 1984), the court stated:

Anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim. *Connell v.*

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Sears Roebuck and Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983); *SSIH Equip. S.A. v. USITC*, 718 F.2d 365, 216 USPQ 678 (Fed. Cir. 1983). In deciding the issue of anticipation, the [examiner] must identify the elements of the claims, determine their meaning in light of the specification and prosecution history, and identify corresponding elements disclosed in the allegedly anticipating reference. *SSIH, supra*; *Kalman [v. Kimberly-Clarke]*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983)] (emphasis added). 221 USPQ at 485.

In *Dewey & Almy Chem. Co. v. Mimex Co.*, Judge Learned Hand wrote:

No doctrine of the patent law is better established than that a prior patent . . . to be an anticipation must bear within its four corners adequate directions for the practice [of the subsequent invention] . . . if the earlier disclosure offers no more than a starting point . . . if it does not inform the art without more how to practice the new invention, it has not correspondingly enriched the store of common knowledge, and it is not an anticipation. 124 F.2d 986, 990; 52 USPQ 138 (2nd Cir. 1942).

Specifically, the cited references disclose fabrics wherein the bonding mechanism is by adhesion. The filaments are bonded together either by meltbonding or with thermoset binders. In contrast, the claimed invention is directed to an easily separatable abrasive material, wherein a fibre-opening machine either completely or substantially separates the fibres. Accordingly, the applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. §102(b) based on either Heyer *et al.* reference.

Claims 9 and 11 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Heyer *et al.* (U.S. Patent No. 5,685,935) in view of Heyer *et al.* (U.S. Patent No. 5,363,604). The applicants respectfully traverse this ground for rejection because the cited references, alone, or in combination, do not disclose or suggest the applicants' claimed invention.

Specifically, the applicants submit that it would not be obvious to modify the Heyer reference to pass the fleece through a fibre-opening machine instead of a rebulking machine. A rebulking machine is merely a heating zone through which an abrasive material may be passed to remelt the binder fibers. As known to artisans possessing ordinary skills in the art, a fibre-opening machine is typically a rotating cylinder clothed in coarse teeth, or spikes, that mechanically rips clumps of fibres from the abrasive fleece material as it is presented to it by breaking a significant number of the resin bonds between the fibres. The resulting free resin/abrasive fibres are then transported in an air stream

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to a collection bin. Therefore, while a rebulking machine strengthens the fibre bonds, a fibre-opening machine breaks resin bonds. Thus, it would not be obvious to modify the Heyer *et al.* references to pass the fleece through a machine whose purpose is to break bonds rather than strengthen them.

A finding of obviousness is proper only when the prior art contains a suggestion or teaching of the claimed invention. Here, neither reference contains a suggestion of the advantageous properties resulting when a fleece cured with a binder is passed through a fibre-opening machine. It is only the applicants' disclosure that provides such a teaching, and the applicants' disclosure cannot be used to reconstruct the prior art for a rejection under §103. This was specifically recognized by the CCPA in *In re Sponnoble*, 56 CCPA 823, 160 USPQ 237, 243 (1969):

The Court must be ever alert not to read obviousness into an invention on the basis of the applicant's own statements; that is we must review the prior art without reading into that art appellant's teachings. *In re Murray*, 46 CCPA 905, 268 F.2d 226, 112 USPQ 364 (1959); *In re Sprock*, 49 CCPA 1039, 301 F.2d 686, 133 USPQ 360 (1962). The issue, then, is whether the teachings of the prior art would, in and of themselves and without the benefits of appellant's disclosure, make the invention as a whole, obvious. *In re Leonor*, 55 CCPA 1198, 395 F.2d 801, 158 USPQ 20 (1968). (Emphasis in original)

The mere fact that the purported prior art could have been modified or applied in a manner to yield applicants' invention would not have made the modification or application obvious unless the prior art suggested the desirability of the modification. *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Moreover, as expressed by the CAFC, to support a §103 rejection, "[b]oth the suggestion and the expectation of success must be founded in the prior art" *In re Dow Chemical Co.*, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). In the references cited in support of the §103 rejection, one finds neither.

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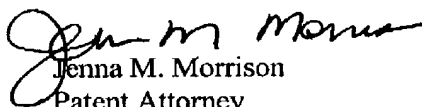
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In view of the foregoing remarks, and the amendments to the claims and the submission of new claims, the applicants believe that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 CFR §§§1.16, 1.17, or 1.492 as required by this paper to Deposit Account No. 19-0065.

The applicants also invite the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



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